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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,788	12/29/2003	Gary B. Solomon	SOL00-01P1C1	2139

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SOLVISIONS TECHNOLOGIES, INT'L  
82 ALBEMARLE RD  
NORWOOD, MA 02062

EXAMINER

RAMIREZ, RAMON O

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/748,788

Applicant(s)

SOLOMON ET AL.

Examiner

RAMON O. RAMIREZ

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/18/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1.7

***Detailed Action***

This is the first Office Action corresponding to original filing. The application contains 31 claims.

***Information Disclosure Statement***

Receipt is acknowledged of Information Disclosure Statement filed Jan 18, 2005, which has been reviewed by the Examiner.

***Specification***

The disclosure is objected to because of the following informalities: the status of the parent application from which this application is a continuation on part must be updated.

Appropriate correction is required.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are rejected under the judicially created doctrine of double patenting over claims 1-36 of U. S. Patent No. 6,691,961 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the instant claims recite basically the same elements of the patent claims; for example the mobility assembly having primary and secondary elements into a cavity for a housing or a platform, a resistance element, etc.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### ***Claim Rejections - 35 USC § 112***

Claims 6-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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It is not clear if Applicant intends to recite the electronic device as a positive element of the combination. The preamble of the independent claims recite the subcombination of an apparatus for providing mobility to an electronic device, but later on the electronic device is recited as part of the invention. For example, in claim 6, lines 3, 4 and 8, 9.

The same pattern is repeated in the other independent claims. Applicant must amend the claims to either recited the electronic device as a positive element, or to provide functional language clearly indicating the electronic device is not a positive element of the invention. For the purpose of the Office Action, the electronic device is not considered a positive element of the invention.

Claim 20 lacks a proper antecedent for "the opening in the revolving element". No art is being applied to this claim due to the indefinite problem.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Bryant et al. (Pat No 1,445,747).

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The patent to Bryant et al. discloses an apparatus capable of providing mobility to an electronic device, comprising a member to be supported, a cavity containing a primary revolving member (6) and at least one secondary member (5).

Claims 6, 9-11, 14-19, 21, 22, and 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Moy et al. (Pat No 6,179,264).

The patent to Moy et al. discloses an apparatus capable of supporting an electronic device, comprising a member to be supported, at least one revolving element (22), and at least one resistance element (18) for resisiting movement of the revolving element.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-4, 15-19, 22, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant et al.

As indicated above, the apparatus disclosed by the patent to Bryant et al. has member supported therein. The specific type of elemet to be supported is considered to be a matter of expediency as long as the appartus is capable of supporting it, which is considered to be the case here.

Claims 7, 8, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moy et al.

As indicated above, the apparatus disclosed by the patent to Moy et al. has member supported therein. The specific type of element to be supported is considered to be a matter of expediency as long as the apparatus is capable of supporting it, which is considered to be the case here.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sterba (905,383), Carter (957,303), Aninger (3,381,330), Aninger (3,401,421) all show a main spherical element and secondary spherical elements. Yang (5,412,838), West (5,419,008) and Chiang et al. (5,934,639) show other devices of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMON O. RAMIREZ whose telephone number is (571) 272-6821. The examiner can normally be reached on MONDAY-FRIDAY, IST FRIDAY OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LESLIE BRAUN can be reached on (571) 272-6815.


The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A shortened period for response to this Office Action expires THREE MONTHS from the mailing date of this action.

ROR  
May 5, 2005

  
RAMON O. RAMIREZ  
Primary Examiner  
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